

## Remarks

### Amendments to the Claims

Independent claims 1-3 are amended to recite a step of determining if the test compound has an effect on a symptom of the disease in an *in vivo* assay. Page 30, lines 28-30 support this amendment.

The amendments to the claims do not add new matter.

### Specification

The specification is amended to indicate trademarks and to correct some minor clerical errors. The amendments to not add new matter.

### Rejection Under 35 U.S.C. § 112 ¶ 1 (enablement)

Claims 1-3, 6, and 8-10 are rejected under 35 U.S.C. § 112 ¶ 1 as not enabled. On page 4 the Office Action acknowledges that the specification enables methods of screening for compounds that bind to NPEPL1 or which regulate NPEPL1 activity, but asserts that the specification does not enable using such compounds to treat the diseases recited in the claims. Applicants respectfully traverse the rejection.

It is black letter law that an applicant need only enable the claimed features of the invention. *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1557, 220 U.S.P.Q. 303, 316 (Fed. Cir. 1983). None of claims 1-3, 6, and 8-10 recites treating a disease with compounds identified in the claimed screening methods. To advance prosecution and to clarify the screening nature of the claimed methods, independent claims 1-3 are amended to recite a step of determining if the test compound has an effect on a symptom of the disease in an *in vivo* assay.

*In vivo* models of the recited diseases are well known in the art, and it would not require undue experimentation to practice the screening methods as claimed.

Please withdraw the rejection.

**Rejection Under 35 U.S.C. § 102(b)**

Claims 1-3, 6, and 8-10 are rejected under 35 U.S.C. § 102(b) as anticipated by Bandman (U.S. Patent 6,203,979). Applicants respectfully traverse the rejection.

A reference cited under 35 U.S.C. § 102 must expressly or inherently describe each element set forth in the rejected claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Bandman does not disclose each element of independent claims 1-3, including step (iii). Bandman therefore does not anticipate any of claims 1-3 6, or 8-10.

Please withdraw the rejection.

Respectfully submitted,

**BANNER & WITCOFF, LTD.**

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